Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT H. HUTCHINSON and GREGORY M. HANKA

Appeal No. 2002-1125
Application 09/233,860

ON BRIEF

Before KRASS, FLEMING, and SAADAT, **Administrative Patent Judges.**

FLEMING, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 3, 5 through 8, 10 through 13, 15, 16 and 18 through 24, all the claims pending in the instant application. Claims 4, 9, 14, and 17 have been canceled.

Invention

The invention is directed to solve the specific problem in connection with "auditing" computer stations connected at nodes on a computer network. The invention solves this problem by

uniquely identifying nodes on a network for the purpose of maintaining a central database reflecting the hardware and software configuration of the respective nodes. See page 2 of Appellants' specification. Referring to figure 1, the prior art has recognize that each network interface card 107(NIC) is the assigned a unique built-in identifier by the manufacturer known as the NIC address. See pages 6 and 7 of Appellants' specification. The problem lies in that the network interface card 107 is not a permanent part of the computer's motherboard 108 and is often removed and plugged into another computers motherboard. Also, the network interface card may become defective and a different network interface card is place in the motherboard of the computer. Thus, any asset management system relies solely on the NIC address for the nodes identification will falter when the node's NIC 107 changes in these ways. See page 8 of Appellants' specification.

Appellants' invention solves this problem by storing the previous used NIC addresses as well as the current NIC address for each node. Referring to figure 3, the client program running on each client node 101 maintain a node-identification record 305 in a local database at a storage 104 of the node. A node-

identification record 304 includes all the previous NIC addresses as well as the current NIC address. See pages 14 and 15 of Appellants' specification.

Independent claim 1 is representative of Appellants' claimed invention and is reproduced as follows:

1. A method, executed by a node on a network, said node comprising at least one asset, of transmitting asset-management information about the node, the method comprising:

(a) determining in a current address value of a network interface card of the node, referred to as a NIC address value;

(b) retrieving, from a data storage at the node, a former NIC address value for the node; and

(c) transmitting asset-management information concerning the node together with the current NIC address value and the former NIC address value.

References

The references relied on by the Examiner are as follows:

de la Salle	5,878,420	Mar. 2, 1999 (Filing date Oct. 29, 1997)
Barroux	5,923,850	Jul. 13, 1999 (Filing date Jun. 28, 1996)

Rejections at Issue

Claims 11 and 12 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regards as the invention. Claims 11 and 12 stand

35 U.S.C. § 112, forth paragraph, for failing to further limit the claim that each depends from. Claims 1 through 3, 5 through 8, 10 through 13, 15, 16, and 18 through 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Barroux or de la Salle.

Throughout our opinion, we make reference to the briefs[1] and the answer for the respective details thereof.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejection and the arguments of Appellants and the Examiner, for the reasons stated **infra**, we reverse the Examiner's rejection of claims 11 and 12 under 35 U.S.C. § 112, second and forth paragraph, and we reverse the Examiner's rejection of claims 1 through 3, 5 through 8, 10 through 13, 15, 16, and 18 through 24 under 35 U.S.C. § 102.

Rejection under 35 U.S.C. § 112

The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 112, second paragraph, because claims 11 and 12 are written in

[1] Appellants filed a second substitute appeal brief on May 21, 2001. We will refer to the second substitute appeal brief as simply the brief. Appellants filed a reply brief on October 15, 2001. The Examiner mailed an office communication on November 7, 2001, stating the reply brief has been entered.

a manner that does not distinguish them as either a method or computer readable medium, but rather some type of hybrid wherein the computer readable medium can not be clearly correlated to specific method steps. See pages 7 and 8 of the answer.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. **In re Johnson**, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). **citing In re Moore**, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112, second paragraph. **See In re Hyatt**, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) **citing In re Borkowski**, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). "The legal standard for definiteness is whether a claim reasonably appraises those of skill in the art of its scope." **In re Warmerdam**, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Upon our review of Appellants' claims 11 and 12, we find nothing more than multiple depended claims reciting a program storage device readable by a processor in a client node. We find that the Examiner has failed to show that one or ordinary skill in the art would have any particular difficulties in determining the scope of the claims 11 and 12.

The Examiner also rejected claims 11 and 12 under 35 U.S.C. § 112, forth paragraph for failing to further limit the claims. See pages 8 and 9 of the answer.

Upon our review of Appellants' claims 11 and 12 we find that they do further limit the claims and that they require a program storage device which further limits the scope of the method claims for which they depend from.

Rejections under 35 U.S.C. § 102

Claims 1 through 3, 5 through 8, 10 through 13, 15, 16, and 18 through 24 stand rejected under 35 U.S.C. § 102 as being unpatentable over de la Salle or in the alternative, over Barroux. The Examiner argues that Barroux and de la Salle disclose determining a current address value of a network interface card of a node, referred to as a NIC, address value, receiving, from a data storage at the node, a former NIC address value for the node and transmitting asset-management information

concerning the node together with the current NIC address value and the former NIC address value. However, the Examiner has not pointed to any specific evidential finding either Barroux or de la Salle to support this portion.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

Appellants point out the each of the independent claims 1, 8, 13, 16, 19, 21, 23, and 24 call for node identification or asset-management information comprising a "current NIC address value" and a "former NIC address value." Appellants argue that nowhere does de la Salle or Barroux teach or suggest retrieving former NIC address value from a network node. See pages 14 through 17 of the brief. Upon on close review of de la Salle and Barroux, we fail to find that these references teach node identification comprising a current NIC address value and a former NIC address value.

In view of the foregoing, we have not sustained the Examiner's rejection of claims 11 and 12 under 35 U.S.C. § 112, second and forth paragraphs. Furthermore, we have not sustained the Examiner's rejection of claims 1 through 3, 5 through 8, 10 through 13, 15, 16, and 18 through 24 under 35 U.S.C. § 102 as being anticipated by Barroux or de la Salle.

REVERSED

ERROL A. KRASS)
Administrative Patent Judge)
)
)
MICHAEL R. FLEMING) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)
MAHSHID SAADAT) INTERFERENCES
Administrative Patent Judge)

MRF:pgc

Appeal No. 2002-1125
Application 09/233,860

Hugh R Kress
Winstead Sechrest & Minick P.C.
910 Travis Suite 2400
Houston, TX 77002